



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,867	11/21/2003	Andrew James Thomas	10.1866 (1585-13U)	2920
31292 7590 08/04/2010 CHRISTOPHER & WEISBERG, P.A. 200 EAST LAS OLAS BOULEVARD SUITE 2040 FORT LAUDERDALE, FL 33301				
EXAMINER				
WINTER, JOHN M				
ART UNIT		PAPER NUMBER		
3685				
MAIL DATE		DELIVERY MODE		
08/04/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/719,867

**Applicant(s)**

THOMAS ET AL.

**Examiner**

JOHN M. WINTER

**Art Unit**

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 June 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 20, 21, 29 and 30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 20-21 and 29-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Acknowledgements***

1. The Applicants amendment filed on June 1, 2010 is hereby acknowledged, Claims 1-14, 20-21 and 28-31 are pending. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 1, 2010 has been entered.

***Response to Arguments***

2. Applicant's arguments with respect to the pending claim have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-14, 20-21 and 28-29 and 31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Claims 1-14, 20-21, 29 and 31 are “software per se” the claimed “structure” of the invention is composed entirely of software (e.g. controller, interface) and as such is non-statutory.

5. Examiner notes that Applicant states “the program controller being in the form of software” at page 11, line 23 of the specification filed on November 11, 2003.

6. Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized. (MPEP 2106.01 --FUNCTIONAL DESCRIPTIVE MATERIAL: “DATA STRUCTURES”)

7. Claim 28 is rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

8. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

9. To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

10. In this particular case, claim 28 fails prong (1) because the “tie” (e.g. a hardware module) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-14,20-21 and 29-30 are rejected under 35 U.S.C. 102(b) as being unpatentable over Katz et al (US Patent 5,926,624).

12. As per claim 1,

Katz ('624) discloses a program controller apparatus arranged for use with a modular system,(Column 11, lines 1-31). Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

Claims 2-14, 20-21 and 29-30 contains similar limitations or are dependant upon claim 1 and are rejected for at least the same reasons.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 1-14, 20-21 and 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al (US Patent 5,926,624) in view of Narasimhalu (US Patent 5,499,298) and further in view of Staley (US Patent 6,073,123).

14. As per claims 1, 20 and 28-30

Katz ('624) discloses a program controller apparatus arranged for use with a modular system, and arranged to manage a program for use with a replaceable hardware module of the modular system, the module being a customer-replaceable part, ( Column 11, lines 1-31)

Katz ('624) does not specifically disclose "the controller being arranged to manage the program automatically according to an agreement between a supplier and a customer, the agreement having terms stored within the program controller". Narasimahalu ('298) discloses "the controller (column 8, lines 44-46) being arranged to manage the program automatically according to an agreement between a supplier and a customer, (column 8, line 64-column 9, line 6; column 8, lines 37-51) the agreement having terms stored within the program controller, (column 10 lines 25-31)". It would be obvious to one having ordinary skill in the art at the time the invention was made to modify the Katz ('624) method in view of Narasimahalu ('298) in order to control usage of content data.

Katz ('624) does not specifically disclose "according to a stored history of use of the hardware module". Staley . ('123) discloses "according to a stored history of use of the hardware module (column 2, lines 7-26; column 7, lines 35-47)". It would be obvious to one having ordinary skill in the art at the time the invention was made to modify the Katz ('624) method in view of Narasimahalu ('298) with Staley ('123) in order to control usage of content data.

Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)). The claimed features of "arranged to manage" etc.. fails to limit the claimed invention.

15. As per claim 2,

Katz ('624) discloses the program of claim 1,  
the history being stored on the hardware module. (Column 8, lines 19-27)

16. As per claim 3,  
Katz ('624) discloses the program controller of claim 1  
arranged to be part of a shelf controller for managing modules in the form of cards for  
carrying out functions of a network element for a telecommunications network.(Figure 4)  
Examiner notes that while features of an apparatus may be recited either structurally or  
functionally, claims directed to an apparatus must be distinguished from the prior art in  
terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ  
226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

17. As per claim 4,  
Katz ('624) discloses the program controller of claim 1  
the program controller being arranged to determine an identity of the system and check it is  
authorized for use with that system. (Column 14, line 28; discussion of “digital signature  
protocol”)  
Examiner notes that while features of an apparatus may be recited either structurally or  
functionally, claims directed to an apparatus must be distinguished from the prior art in  
terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ  
226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

18. As per claim 5,

Katz ('624) discloses the program controller of claim 1  
the history comprising a program identifier of a program previously loaded on the module.  
(Column 8, lines 19-27)

19. As per claim 6,

Katz ('624) discloses the program controller of claim 1  
the history comprising a licence identifier of a program previously loaded on the module.  
(Column 8, lines 19-27)

20. As per claim 7,

Katz ('624) discloses the program controller of claim 1  
arranged to be located remotely from the system, and coupled to the system by a  
communications link.(Figure 4)

Examiner notes that while features of an apparatus may be recited either structurally or  
functionally, claims directed to an apparatus must be distinguished from the prior art in  
terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ  
226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

21. As per claim 8,

Katz discloses the program controller of claim 1, arranged to maintain an inventory record  
of identities and relationships of modules, programs, and licence information for a given

customer. (Column 14, line 28; discussion of “digital signature protocol”)

Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

22. As per claim 9,

Katz ('624) discloses the program controller of claim 1 arranged to determine any changes in modules, at initialization, and to check the configuration of any newly coupled modules. (Column 14, line 28; discussion of “digital signature protocol”) Examiner notes that while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ 226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

As per claim 10,

23. Katz ('624) discloses the program controller of claim 1

Wherein the controller copies all or part of the program to the module at initialization. (Column 14, line 28; discussion of “digital signature protocol”)

24. As per claim 11,

Katz ('624) discloses the program controller of claim 1

Wherein the controller authorizes all or part of the program for the module at initialization.  
(Column 15, line 63 – column 17, line 24)

25. As per claim 12,  
Katz ('624) discloses the program controller of claim 1  
the history comprising an indication of which systems the module has been coupled to.  
(Column 14, line 28; discussion of “digital signature protocol”)

26. As per claim 13,  
Katz ('624) discloses the program controller of claim 1  
the program having license information indicating a capability licensed, the program  
controller being arranged to configure the program according to the capability licensed.  
(Column 14, line 28; discussion of “digital signature protocol”)  
Examiner notes that while features of an apparatus may be recited either structurally or  
functionally, claims directed to an apparatus must be distinguished from the prior art in  
terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ  
226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

27. As per claim 14,  
Katz ('624) discloses the program controller of claim 1

the program having license information indicating license expiry information. (Column 14, line 28; discussion of “digital signature protocol”)

28. As per claim 21,  
Katz ('624) discloses the program controller of claim 20  
having an interface for coupling to a remote server to pass  
information for a supplier to maintain an inventory of programs and modules.(Figure 4)  
Examiner notes that while features of an apparatus may be recited either structurally or  
functionally, claims directed to an apparatus must be distinguished from the prior art in  
terms of structure rather than function alone (MPEP 2214; *In re Swineheart*, 169 USPQ  
226; *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997)).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner  
should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The  
examiner can normally be reached on M-F 8:30-6, 1st Fridays off.  
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,  
Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the  
organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3685

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685